

## **REMARKS**

### **I. Introduction**

Claims 1 to 19 are pending in the present application. In view of the foregoing amendment and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As an initial matter, it is noted that the Office Action Summary does not include an acknowledgment of the claim for foreign priority and does not indicate whether all certified copies of the priority documents have been received. In this regard, a claim of priority to Application No. 202 20 177.5, filed in the Federal Republic of Germany on December 30, 2002, and Application No. 203 04 381.2, filed in the Federal Republic of Germany on March 13, 2003, was made inter alia, in the "Combined Declaration and Power of Attorney for Patent Application" filed on January 29, 2004. Certified copies of these two applications were filed on September 26, 2003. Applicants respectfully request an acknowledgment of the foreign priority claim and an indication of whether the certified copies of the priority documents have been received in the next Office communication.

### **II. Objection to the Specification**

As regards the objection to the Specification, there is no requirement that section headings appear without underlining. In this regard, 37 C.F.R. § 1.77(c) states that "[t]he text of the specification sections . . . **should be**" -- but are not required to be -- "preceded by a section heading in uppercase and without underlining or bold type."

Furthermore, to amend the section headings in the manner required under 37 C.F.R. § 1.121 would result in ambiguity. In this regard, an amendment to a section heading is considered to be an amendment of a paragraph of the Specification, and an amendment to a paragraph of the Specification requires the full text of the paragraph with markings to show all changes relative to the previous version of the paragraph with underlining to show additions and strike-through to show deletions. Thus, since the paragraph headings are already underlined, their deletions would be indicated by underlined and struck-through text while their additions would be indicated by underlining. For example, to comply with 37 C.F.R. § 1.121, an attempt to amend the section heading "CROSS-REFERENCE

TO RELATED APPLICATIONS” to --CROSS-REFERENCE TO RELATED APPLICATIONS-- would require the replacement paragraph, “CROSS-REFERENCE TO RELATED APPLICATIONS CROSS-REFERENCE TO RELATED APPLICATIONS”.

In view of all of the foregoing, withdrawal of this objection is respectfully requested.

**III. Objection to the Claims**

Claim 3 was objected to due an alleged informality. In this regard, claim 3 has been amended herein without prejudice to change “arranged an” to --arrange in an--. In view of all of the foregoing, withdrawal of this objection is respectfully requested.

**IV. Rejection of Claim 19 Under 35 U.S.C. § 112**

As regards the rejection of claim 19 under 35 U.S.C. § 112, second paragraph, the Examiner will note that “or a motor vehicle” has been changed to --on a motor vehicle--. Therefore, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claims 1 to 4 and 17 to 19 Under 35 U.S.C. §103(a)**

Claims 1 to 4 and 17 to 19 were rejected under 35 U.S.C. §103(a) as unpatentable over the combination of U.S. Patent No. 5,713,501 (“Yokoyama et al.”), U.S. Patent No. 5,522,530 (“Boettcher”), U.S. Patent No. 6,701,913 (“LeDuc et al.”) and U.S. Patent No. 6,712,171 (“Farmer”). Applicants respectfully submit that the combination of Yokoyama et al., Boettcher, LeDuc et al. and Farmer does not render unpatentable claims 1 to 4 and 17 to 19 for at least the following reasons.

Yokoyama et al. purportedly relate to an automobile having a spare tire carrier with a lock mechanism including rear door bottom panel support. Boettcher purportedly relates to a hand truck sentry system. LeDuc et al. purportedly relate to a swingable apparatus attachable to a vehicle for transporting a cooking device and permitting access to the vehicle. Farmer purportedly relates to a refueling safety switch. Nowhere does the combination of Yokoyama et al., Boettcher, LeDuc et al. and Farmer disclose, or even suggest, at least one sensor configured to detect at least one position of a spare-wheel carrier and to transmit the at least one position to a control unit, the control unit configured to enable and block functions of a motor vehicle in accordance with the position of the spare-wheel carrier, as recited in claims 1 and 17, means for detecting at least one position of a spare-wheel carrier,

means for enabling and blocking functions of a motor vehicle in accordance with the position of the spare-wheel carrier, and means for transmitting the position of the spare-wheel carrier from the detecting means to the enabling and blocking means, as recited in claim 18, or detecting at least one position of a spare-wheel carrier on a motor vehicle, the spare-wheel carrier pivotable at a body of the motor vehicle and arranged in a region of a tailgate of the motor vehicle and enabling and blocking functions of the motor vehicle in accordance with the position of the spare-wheel carrier, as recited in claim 19. Therefore, the combination of Yokoyama et al., Boettcher, LeDuc et al. and Farmer does not disclose, or even suggest, all of the features of claims 1 and 17 to 19.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, the combination of Yokoyama et al., Boettcher, LeDuc et al. and Farmer does not disclose, or even suggest, all of the features of claims 1 and 17 to 19. Therefore, Applicants respectfully submit that claims 1 and 17 to 19 are not rendered unpatentable by the combination of Yokoyama et al., Boettcher, LeDuc et al. and Farmer.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to

support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

The use of a sensor and computer system to shut down an engine when the fuel door is open does not render it unpatentable to disable or block a vehicle function when attempting to drive with an unlocked tire-carrier. The system of Farmer prevents a vehicle's engine from running while refueling so as to prevent ignition of fumes. Farmer does not disclose, or even suggest, disabling the engine when a fixture of the automobile, such as a tire carrier, is unlocked. Farmer does not even mention a tire-carrier. Nor do LeDuc et al. and Boettcher disclose, or even suggest, anything beyond notifying a driver that a cooking device and handtruck are unlocked. None of the references suggest taking any action, including disabling or blocking a vehicle function, in response to an unlocked fixture secured to an exterior

of a vehicle other than notifying a driver that the fixture is unlocked via a display unit inside the vehicle. Farmer disables the vehicle's engine so as to prevent ignition of fumes not damage to the vehicle from an unlocked fixture connected to an exterior of the vehicle. Therefore, it is respectfully submitted that it would not have been obvious to modify the vehicle of Yokoyama et al. so as to include a modified version of the sensor systems of Boettcher and LeDuc et al. including the Farmer vehicle disabling feature. The Office Action's allegation to the contrary are apparently based merely upon conclusory hindsight and reconstruction, which, as detailed above, do not provide a proper basis for an obviousness rejection.

In view of all of the foregoing, it is respectfully submitted that the combination of Yokoyama et al., Boettcher, LeDuc et al. and Farmer does not render unpatentable claims 1 to 4 and 17 to 19.

Claims 2 to 4 ultimately depend from claim 1 and therefore include all the features of claim 1. Accordingly, it is respectfully submitted that these dependent claims are allowable for at least the same reasons provided above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

#### **VI. Allowable Subject Matter**

Applicant notes with appreciation the indication of allowable subject matter contained in claims 5 to 16. The Examiner will note that each of claims 5, 14 and 16 has been rewritten herein in independent form to include all of the limitations of its respective base claims and any intervening claims. Claims 6 to 13 ultimately depend from claim 5, and claim 15 depends from claim 14. It is therefore respectfully submitted that claims 5 to 16 are in condition for immediate allowance.

**VII. Conclusion**

Applicants respectfully submit that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

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